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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,968	10/15/2001	Rikio Shiba	862.C2245	1046
5514	7590	09/20/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				FISCHETTI, JOSEPH A
ART UNIT		PAPER NUMBER		
3627				

DATE MAILED: 09/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/975,968	SHIBA ET AL.	
	Examiner Joseph A. Fischetti	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 06 July 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,58 and 67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,58,67 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____.                                     |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date. _____.  | 6) <input type="checkbox"/> Other: _____.                         |

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1,58 and 67 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant has attempted to recite methods steps as wherein clauses, thereby loosing the effect of a process. It is recommended that these claims be reworked to recite the items as step plus function elements rather than as wherein clauses which will give them the effect of positive limitations.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 58,67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manchala et al. in view of Sato et al.

Manchala disclose a processing method of ordering a new consumable to be used by a printer and returning a used consumable, used by the printer, being performed by an information processing system that communicates with a terminal via the Internet (network based system is read as an internet or capable of functioning as an internet based system). Manchala discloses *the* information processing system (service center 101) receiving, from the terminal, participating information, indicating whether or not a user participates in a return service for corresponding to a particular type of consumable (pre-selected list of vendors indicates participation or not), wherein the return service is provided by the system and is a service by which the user returns the used consumable (toner return service is part of toner replenishment); Manchala discloses information processing system setting a participating flag corresponding to the user (list of vendors is set by the customer), which is managed by the information processing system (system col. 3 lines 40 et seq.), in a memory *unit in* accordance with the received participating information, wherein the information processing system manages a plurality of participating flags corresponding to different types of consumables ordered by the user (the different types of consumables are read as nonfunctional descriptive material). In Manchala the information processing system receiving, from the terminal, a request for ordering a new consumable (system automatically places order col. 3 line 31);

However, Manchala does not disclose the remaining portions of the claim recitations, except for the last wherein clauses.

Sato et al. do disclose receiving the request and orders the new consumable [0158], and transmitting first information containing data fields and display of Fig. 13 fields setting e.g., collection date etc. [0159] for data used in ordering the new consumable (fig.4), wherein the data

fields are displayed on a display screen of the terminal, *whereby the user inputs* data into the data fields (fig. 4 requires data to complete the process). Sato et al. further discloses in [0158] in response to receiving the request (response read as OK) the information processing system transmitting second information, wherein the second information is displayed *on the display screen (window of Fig. 14 is subsequently displayed* of the terminal (second information is read as data in Fig 4, noting the claims do recite steps and thus are not set forth a time line of information presentation to order of purchase); Sato discloses the second information comprises one of a message (a) prompting the user to participate in the return service [[0158]] acknowledgement required OK? It would be obvious top modify Manchala to include the display screen interface of Sato et al. the motivation being the easy of data transfer through formatting.

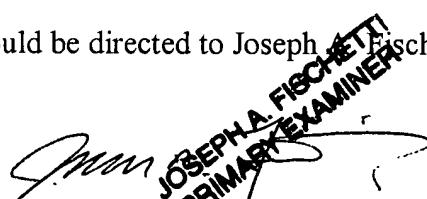
Notwithstanding, Manchala disclose wherein the second information comprises message in the case *where a participating flag corresponding to the user indicates that the user already participates in the return service read as the flag of being on the pre-selected list of vendors and presents an incentive point best price among vendors.* Since the last three wherein clauses of the base claims are contingencies, Manchala et al.'s answering one of the contingencies is deemed to answer these recitations.

Re claim 67: official notice is taken and made final of the process of managing order histories and tracking returns. Notwithstanding the system in Manchala et al. clearly or inherently manages and tracks these items.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Joseph A. Fischetti at telephone number 571 272 6780.



JOSEPH A. FISCHETTI  
PRIMARY EXAMINER

Joseph A. Fischetti  
Primary Examiner  
Art Unit 3627